

### **REMARKS/ARGUMENTS**

Claims 1-26 are pending and at issue in the present application.

Applicants traverse the rejections of claims 1-9, 11-22, and 24-26 as anticipated by or obvious over Simpson, A., Mastering WordPerfect® 5.1 & 5.2 for Windows, 1993, pages 539-579 and 852-859 (hereinafter "Simpson"). Applicants further traverse the rejections of claims 10 and 23 as obvious over Cohen et al. in view of Mastie.

Claim 1, and claims 2-15 dependent directly or indirectly thereon, recite a software system for generating a second page description file from a first page description file. The software system comprises a first routine for generating a template, a second routine for extraction of data from the first page description file to generate a database for storing the extracted data, and a third routine for generating a second page description file from the template and the database.

Claim 16, and claims 17-26 dependent directly or indirectly thereon, recite a method of generating a second page description file from a first page description file including the steps of generating a template, extracting data from the first page description file in an automated fashion to generate a database for storing the extracted data, and generating a second page description file from the template and the database.

None of the art teaches or suggests a software system for or method of generating a second page description file from a first page description file including a routine for or the steps of extracting data from a first page description file to generate a database, as specified by the claims at issue.

In fact, Simpson discloses using Wordperfect® for converting an ASCII comma-delimited text file representing a database into a Wordperfect® formatted secondary merge file, which represents the database having field names and records to be used by Wordperfect®. A primary merge file is created in Wordperfect®, wherein the primary merge file includes static information and field names. When a merge is performed, variable data from the secondary merge file is inserted into the field names of the primary merge file for each record, thus creating a customized document for each record.

As described in the specification of the present application, a page description file is a page mark-up or layout file, such as a QuarkXPress® file, an HTML file, an Acrobat® PDF file, or any other type of file that comprises content and layout information for one or more

pages to be printed, displayed, or otherwise distributed. Simpson does not extract data from a first page description file to generate a database. Instead, Simpson extracts data from a first database formatted in a first manner to create a second database formatted in a second manner.

Cohen et al. discloses a document generation and delivery system that stores a number of pre-defined overlays, wherein each overlay includes a plurality of data fields. A set of instructions is generated to define the location of each data field within the overlay. Input data, received in the form of character strings, identifies the overlay to be used and provides specific data for insertion into the defined data fields within the selected overlay in accordance with the associated set of instructions.

Mastie discloses a method and apparatus for assembling a set of input page files in the correct sequence to generate a single output file in the form of a digital book.

Because the prior art does not disclose each of the elements recited by the claims at issue, it follows that such claims are not anticipated thereby.

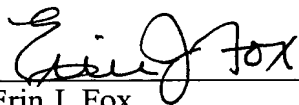
Furthermore, because none of the art discloses or suggests that it would have been desirable or even possible to extract data from a first page description file to generate a database for storing the extracted data, or to provide a routine that accomplishes this function, as specified by claims 1-26, it is evident that the claims are not obvious thereover. The prior art must disclose at least a suggestion of an incentive for the claimed combination of elements in order for a *prima facie* case of obviousness to be established. See *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Accordingly, the rejection of the claims at issue should be withdrawn.

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For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims at issue and reconsideration thereof are respectfully requested.

Respectfully submitted,

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